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OFFICE OF PETITIONS

In re Patent of Strub et al.	:	
Patent No. 7,519,271	:	
Issue Date: April 14, 2009	:	DECISION ON APPLICATION
Application No. 10/764,309	:	FOR RECONSIDERATION OF
Filing Date: January 22, 2004	:	PATENT TERM ADJUSTMENT
Attorney Docket No. 345288015US	:	

This is in response to the "Application for Patent Term Adjustment Reconsideration Under 37 C.F.R. § 1.705(b)" filed March 4, 2009, and the "Application for Patent Term Adjustment Reconsideration Under 37 C.F.R. § 1.705(d)" filed May 7, 2009. Patentees request that the determination of patent term adjustment indicated on the issue notification (and on the patent) be corrected from 943 days to 1,437 days.

The request for reconsideration of the patent term adjustment under 37 C.F.R. 1.705(b) is **dismissed as moot**.

The request for reconsideration of the patent term adjustment under 37 C.F.R. 1.705(d) is **dismissed**.

The Request Under 37 CFR 1.705(b)

The request under 37 CFR 1.705(b) is based solely on an assertion patentees are entitled to additional patent term adjustment based on the failure of the Office to issue the patent within three years of the filing date of the application. Knowledge of the actual date a patent issues is required to properly calculate a term adjustment pursuant to 37 CFR 1.703(b). As a result, the term adjustment shown on a Determination of Patent Term Adjustment mailed with a Notice of Allowance is the term adjustment *prior to* any adjustment pursuant to 37 CFR 1.703(b). The term adjustment listed on the patent will include any adjustments pursuant to 37 CFR 1.703(b). Therefore, the proper vehicle to assert patentees are entitled to additional patent term adjustment based on the failure of the Office to issue the patent within three years of the filing date of the application is a request under 37 CFR 1.705(d) instead of 37 CFR 1.705(b). Patentees have filed a request under 37 CFR 1.705(d). The Office will consider patentee's arguments as part of the Office's consideration of the request under 37 CFR 1.705(d) and the request under 37 CFR 1.705(b) is dismissed as moot.

The Request Under 37 CFR 1.705(d)

On January 6, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated the patent term adjustment to date is 943 days. On April 14, 2009, the application matured into United States Patent No. 7,519,271 with a revised patent term adjustment of 943 days. This request for reconsideration was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentees request recalculation of the patent term adjustment. Patentees contend it is entitled to additional patent term adjustment based on the failure of the Office to issue the patent within three years of the filing date of the application. Patentees assert the application was filed January 22, 2004, and the application was issued as a patent 3 years and 813 days later on April 14, 2009.

Patentees contend the total patent term adjustment should be 1,437 days, which is the sum of the 813 days of delay in the issuance of the patent (“Three Year Delay”)¹ and 990 days of delay due to other types of Office delay (“Examination Delay”)² reduced by 319 days of overlap and 47 days of applicant delay.

The Office agrees the Examination Delay is 990 days, and the applicant delay is 47 days. The Office does not agree that the Three Year Delay is 813 days. The Office does not agree the period of overlap is 319 days.

In this case, a Request for Continued Examination (“RCE”) was filed December 23, 2008. Pursuant to 35 U.S.C. § 154(b)(1)(B), the period of adjustment under 35 U.S.C. § 154(b)(1) does not include the number of days from the date a request for continued examination is filed until the patent is issued.³ In other words, the filing of a RCE cuts-off the applicants’ ability to accumulate any additional patent term adjustment against the three-year pendency provision, but does not otherwise affect patent term adjustment.⁴

¹ The period of adjustment under 37 C.F.R. § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. § 1.111(a) or the national stage commenced under 35 U.S.C. § 371(b) or (f) in an international application and ending on the date the patent was issued. The period of adjustment does not include any time period falling under 35 U.S.C. § 154(b)(1)(B)(i)-(iii).

² “Examination Delay,” as used in this decision, references delay under 35 U.S.C. §§ 154(b)(1)(A) and (B).

³ *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 56,366, 53,370-53,371 (September 18, 2000), 1239 Off. Gaz. Pat. Office (October 3, 2000):

35 U.S.C. 154(b)(1)(B) provides that an applicant may receive a term adjustment if the application is not issued within three years of the filing date of the application, excluding (among other things) any time consumed by continued examination requested under 35 U.S.C. 132(b). Once a request for continued examination under 35 U.S.C. 132(b) and § 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and § 1.114.

⁴ [I]f a request for continued examination is filed in an application, the applicant may still accrue patent term adjustment under 35 U.S.C. 154(b)(1)(A) or (C). *Changes to Implement Patent Term Adjustment Under Twenty-*

The period of delay accumulated under 37 CFR 1.703(b)(1) is the period of time from the filing date to the date the RCE was filed.⁵ Therefore, the period of adjustment under 35 U.S.C. § 154(b)(1) is 701 days counting the number of days beginning on the filing date, January 22, 2004, and ending on the date the RCE was filed, December 23, 2008.

The total amount of adjustment one can receive as a result of delay under 35 U.S.C. § 154(b)(1) is limited by 35 U.S.C. § 154(b)(2)(A) which states,

To the extent that time periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

Patentees do not dispute that the total period of Office delay is the sum of the period of Three Years Delay (701 days - see above) and the period of Examination Delay (990 days) to the extent that these periods of delay are not overlapping. However, patentees assert the period of overlap is 319 days. The Office does not agree with patentees' conclusion that the amount of overlap between the Three Year Delay and Examination Delay is 319 days. The Office contends the proper amount of the overlap is 701 days.

The Office's position regarding the proper interpretation of 35 U.S.C. § 154(b)(2)(A) is as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).⁶

The relevant time period when determining if periods of delay "overlap" is the time period from the filing date of the application, to the date the RCE was filed.⁷ In this case, all the Examination Delay occurred prior to the filing of the RCE. Therefore, the entire Examination Delay of 990 days took place within the relevant time period. In other words, all of the Three Year Delay of 701 days overlaps with the Examination delay of 990 days. Office delay resulted in the patent issuing 990 days later than it would have issued but for Office delay, not 990 days + 701 days

Year Patent Term; Final Rule, 65 Fed. Reg. 56,366, 53,370-53,371 (September 18, 2000), 1239 Off. Gaz. Pat. Office (October 3, 2000).

⁵ The instant case does not contain any time periods falling under 35 U.S.C. § 154(b)(1)(B)(ii)-(iii).

⁶ *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004) (citing *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704, 21706 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100, 101 (May 18, 2004)).

⁷ The instant case does not contain any time periods falling under 35 U.S.C. § 154(b)(1)(B)(ii)-(iii).

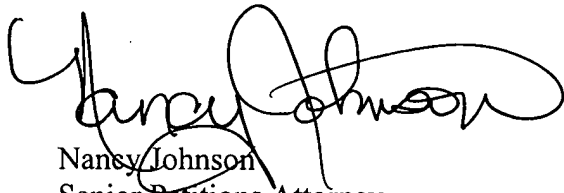
later. Accordingly, 990 days of patent term adjustment (not 990 and 701 days) was properly entered since the period of delay of 701 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 990 days of Examination Delay.

The total patent term adjustment and the number of days issuance of the patent was delayed due to Office delay is 943 days, which is the sum of the 701 days of delay in the issuance of the patent ("Three Year Delay")⁸ and 990 days of delay due to other types of Office delay by the Office ("Examination Delay") reduced by 701 days of overlap and 47 days of applicant delay.

For the reasons previously discussed, the Office acted properly when it did not increase the patent term adjustment as a result of the Office taking in excess of 3 years to issue the patent. Therefore, the patent term adjustment will remain 943 days and the patent term adjustment on the patent will not be changed.

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

⁸ The period of adjustment under 37 C.F.R. § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. § 1.111(a) or the national stage commenced under 35 U.S.C. § 371(b) or (f) in an international application and ending on the date the patent was issued. The period of adjustment is reduced by any time period falling under 35 U.S.C. § 154(b)(1)(B)(i)-(iii).